

## REMARKS

Prior to this Amendment, claims 1-56 were pending in the application. Claims 3, 5, 10-17, 27, 29 and 34-41 were withdrawn in view of the earlier restriction requirement.<sup>2</sup> Claims 1, 2, 4, 6-9, 19-26, 28, 30-33 and 42-56 were active.

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~~In this Amendment, Applicant elects to take issuance of the claims deemed~~ allowable in the Office Action of May 1, 2003 (hereinafter "Office Action No. 2"), and to merely cancel all other claims to gain early issuance of a patent. Accordingly, in this Amendment, claims 2-5, 8, 10-17, and 24-56 are being canceled without prejudice, waiver or disclaimer. New claims 57-86 are being added. Thus, upon entry of the Amendment, claims 1, 6-7, 9, 18-23 and 57-86 will be pending.

### Subject Matter Deemed Allowable In Office Action No. 2

In Office Action No. 2, at page 4, Section 8, claims 2, 9, 18, and 19 were merely objected to as being dependent upon a rejected base claim, but were otherwise deemed allowable. In view of this, as noted above, Applicant now wishes merely to gain formal allowance of those claims and gain early issuance of a patent on them.

Claim 2 has been written in independent form by amending pending claim 1 to incorporate the additional limitations of claim 2.

Claim 9 has been amended to assume independent form, and to include the

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<sup>2</sup> There appears to be a minor discrepancy between the examiner's count of withdrawn claims versus those withdrawn in view of the Office Action of March 19, 2003. Applicant has responded herein according to the apparently revised status of the claims as set forth in the Office Action of May 1, 2003.

limitations of originally-filed claim 1, from which it depended.

Claim 18 also has been amended to take independent form, and to include the limitations of originally-filed claim 1, from which it also depended. Claim 19 has been amended to depend from claim 18 as amended here.

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Claims 6 and 7 and 20-23 depend directly or indirectly from newly amended claim 1 (allowable original claim 2 as rewritten in independent form), and are allowable based at least on that dependence.

New claims 57-70 also depend from newly amended claim 1 and are allowable based at least on that dependence as well.

New claims 71-86 depend from newly amended claim 18, and are allowable based at least on that dependence.

### **Claim Objections**

The objection to claims 2 and 7 has been addressed by deleting the language “and mixtures thereof.” It therefore has been overcome.<sup>3</sup> It should be noted, however, that the amendment of these claims to delete this language merely addresses an informality to improve the clarity and readability of the claim, and in no way concerns the patentability of the invention. From a reading of the claim as a whole, before and after amendment, and particularly in view of the open-ended transition phrase “comprising,” it is clear that the compositions according to the

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<sup>3</sup> Applicant has canceled claims 26 and 31 without prejudice. For that reason, the objection as to those claims is not addressed herein. Applicant reserves the right to address the objection as to these claims to the extent a renewed objection arises in subsequent prosecution involving those claims.

invention may include mixtures of the recited parent androgens and alkylcarbonate esters. Thus, no narrowing of the claim scope has occurred and no estoppel arises.

#### **Claim Rejections – 35 U.S.C. § 112**

Although Applicant respectfully traverses the rejection of claims 20-23, Applicant has amended the pending claims to recite a “composition.” This amendment has been made to make explicitly clear that the invention is to be construed broadly to include not only “compounds” in a narrow sense, but compositions of matter for increasing the concentration of a parent androgen in a subject *in vivo*. Applicant acknowledges that the examiner has interpreted these claims in the same way, based for example on the statement in Office Action No. 2 at page 3, Section 5. In view of the foregoing, Applicants submit that the rejection of claims 20-23 was misplaced or at least has been overcome, and should be withdrawn.

#### **CLAIM REJECTIONS – 35 U.S.C. § 102**

The rejections of previously pending claims 1, 4, 6-8, 20 and 22 have been mooted by the amendments set forth herein. It should be noted, however, that, as stated above, it is Applicant’s desire to gain early formal allowance of the claims deemed in Office Action No. 2 to be allowable, and to gain early issuance of a patent with these claims. Accordingly, the cancellation of claims and the amendment of claims to depend from the allowable claims was solely directed to that objective. Applicant respectfully takes issue with the rejections, and fully reserves his right to challenge their propriety and to establish the patentability of those canceled or pre-

amended claims if the rejections are reasserted in subsequent prosecution of them in another application.

Neither the amendments to the claims nor the positions set forth herein have been intended to, nor had the effect of, narrowing the protectable scope of the invention. They merely have acted upon the examiner's characterization of the

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pending claims as allowable, and addressed informalities. Accordingly, no amendments or remarks have been made for any substantial reason related to patentability, and no estoppel applies.

### **Conclusion**

In view of the foregoing, Applicant requests reconsideration of the application and passage of all pending claims to issue.

Applicant has concurrently filed a Petition of Extension of Time. Also attached hereto is a check to cover the extension fee. If the amount of this check is deficient or if there are any other fees due in connection with this application, please charge the fees to our Deposit Account No. 501324.

Dated: November 3, 2003

Respectfully submitted,

A handwritten signature in cursive script, reading "Sarah L. Malcolm".

Sarah L. Malcolm  
Reg. No. 53,259